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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/514,946 | 02/28/2000 | Richard Fernandes | 2470-105A | 8679 |

6449 7590 02/20/2002

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EXAMINER

CARLSON, JEFFREY D

| | |
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| ART UNIT | PAPER NUMBER |
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2162

DATE MAILED: 02/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,946

Applicant(s)

FERNANDES, RICHARD

Examiner

Jeffrey D. Carlson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 16-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 16 lines 4-5, the step of "storing a consumer identifier contained in an activity information of said computer" is unclear. While storage of a consumer identifier is clearly set forth, it is unclear whether the activity information is positively required by the claim.
- Claim 16 lines 6-7, there is no antecedent basis for any network sties(s) stored in the activity information.
- Claim 16 lines 15-16, there is no antecedent basis for any preference information.
- Claim 20 line 2, there is no antecedent basis for the second site

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1, 5-7, 10-12, 15-18 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Gardenswartz et al (US6055573). Gardenswartz et al teaches prior art systems that provide targeted banner ads to Internet web site visitors.

Regarding claim 1, 5-7, 10, 12, 15, 17, 18 and 21, Gardenswartz et al teaches Internet-connected users that collect cookies stored on their machines as they visit different web sites. When the user accesses a particular web site, the cookie (including userID) is uploaded to the web server [col 2 lines 11-19] so as to request customization of the web page. This uploading/reading inherently includes at least temporary storage of the cookie's information (sites visited, userID, activity) and is taken to provide consumer information storage. Because cookies are used to track online activity, the web server can deliver a targeted advertisement based on the users online activity. [col 2 lines 20-28]. The user's tastes and preferences can be inferred from the activity and this can be used as a basis for the selection of the targeted ad [col 2 lines 28-33].

Regarding claim 11, the stored preferences information can be taken to be the sites visited (user prefers those sites). Further, the inferred preferences [col 2 lines 28-33] used to target an ad inherently requires at least temporary storage of such preference information to carry out such targeting by the computer system described by Gardenswartz et al.

Regarding claim 16, the cookie-based storage of sites visited is taken to include at least a page visited. Claimed steps of storing products reviewed and purchases are optional and not required by the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al. Gardenswartz et al teaches using cookies to track user's Internet browsing history. A user visiting/reviewing e-commerce sites that include products or services would have a history that included association with such products or services. Gardenswartz et al teaches using the Internet to visit/buy products online. It would have been obvious to one of ordinary skill at the time of the invention for a user having cookie-based history tracking described by Gardenswartz et al to have visited an e-commerce site so that Internet shopping can be carried out.

6. Claims 2-4, 13 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al in view of Roth et al (US6285987). Roth et al teaches a central server that is used to carry out targeted Internet advertising. Roth et al teaches tracking user's visits to particular web sites [col 1 lines 30-38] and using this information to provide targeted ads. The centralized system includes database storage of ads as well as storage of information regarding the subscribing sites [col 2 lines 1-5]. Depending of the customer visiting, the characteristics of the subscribing site and other information, an ad is selected to be displayed to the user [col 2 lines 20-41]. It would

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have been obvious to one of ordinary skill at the time of the invention to have implemented a centralized system as described by Roth et al so that targeted ads can be selectively sent to web site viewers of subscribing member web sites.

7. Claims 8 (alternatively), 9 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardenswartz et al in view of Travis et al (US2002/0010668). Travis et al teaches dynamically providing targeted ads to viewers of web sites. Travis et al teaches a database of user profiles/preferences that includes purchases made and products reviewed which is used during selection of a banner ad [para 21]. It would have been obvious to one of ordinary skill at the time of the invention to have used such stored preference information as products/services reviewed and products/services purchased to create a more accurate profile so that the system of Gardenswartz et al can deliver a more effective ad.

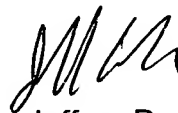
8. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over San Jose Mercury News (Net issue gains steam..., 6/4/97). San Jose Mercury News teaches the sale of cookie-derived activity consumer profiles for marketing purposes. It would have been obvious to one of ordinary skill at the time of the invention to have purchased such user cookie/based activity information and relied on such information to deliver the targeted ads of Gardenswartz et al, so as to compile more complete profiles which lead to more effective targeting of ads.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 703-308-3402. The examiner can normally be reached on 8:30-6p, off on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-6606 for regular communications and 703-305-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Jeffrey D. Carlson
Examiner
Art Unit 2162

jdc
February 14, 2002